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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/740,211 | 12/18/00 | COUTO | L AVIGEN.003C1 |

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| EXAMINER |
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WHITEMAN, B

| ART UNIT | PAPER NUMBER |
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| 1633 | 5 |

DATE MAILED:

10/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/740,211

Applicant(s)

COUTO ET AL.

Examiner

Brian Whiteman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

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DETAILED ACTION

Claims 2-19 are pending and under consideration in the instant application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2-7 and 18, drawn to a pharmaceutical composition comprising two recombinant adeno-associated virions (AAV), each AAV encoding a portion of a Factor VIII protein, wherein said portions collectively encode a functional Factor VIII protein, classifiable in class 424, subclass 93.2.
- II. Claims 8-17 and 19, drawn to a pharmaceutical composition comprising a recombinant AAV comprising a nucleotide sequence encoding at least one functional Factor VIII protein, classifiable in class 424, subclass 93.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are distinct. Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention I is directed to two recombinant AAVs, each comprising of a portion of a Factor VIII protein. Invention II is directed to a recombinant AAV comprising of at least one functional Factor VIII subunit operably linked to a tissue-specific promoter. Each composition requires a different mode of operation and has a different effect. Invention I requires that the two recombinant AAV virions, each encoding a portion of the Factor VIII protein locate to the same tissue and that the tissue allows production of the biologically active Factor VIII by combining the two nucleotide sequences each encoding a portion of Factor VIII. Whereas, invention II is directed to a

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functional Factor VIII subunit that does not require combining another nucleotide sequence with it to produce a functional Factor VIII protein. Furthermore, the search of a pharmaceutical composition comprising of a first AAV virion comprising a first nucleotide sequence encoding a portion of a Factor VIII protein and a second recombinant AAV comprising a second nucleotide sequence encoding a portion of Factor VIII protein would not overlap with a search of a pharmaceutical composition comprising of a recombinant AAV comprising a nucleotide sequence encoding at least one functional Factor VIII subunit. Thus, inventions I and II are distinct.

Because these inventions are distinct for the reasons given above and the literature search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

It would be unduly burdensome for the examiner to search and consider patentability of all of the presently pending claims, a restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 § 1.17(h).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Tracey Johnson whose telephone number is (703) 305-2982.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (703) 305-0775.

The examiner can normally be reached on M-F, (700-400 EST), with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Clark can be reached at (703) 305-4051.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 308-2742.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-8724.

Brian Whiteman 1633
10/5/01


DAVE T. NGUYEN
PRIMARY EXAMINER